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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,606	01/22/2001	Kenneth K. Smith	10001436-1	2527
22879	7590	03/16/2005	EXAMINER	
HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			HOFFMAN, BRANDON S	
			ART UNIT	PAPER NUMBER
			2136	

DATE MAILED: 03/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action
Before the Filing of an Appeal Brief**

Application No.

09/767,606

Applicant(s)

SMITH, KENNETH K.

Examiner

Brandon S Hoffman

Art Unit

2136

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 February 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires _____ months from the mailing date of the final rejection.
- b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The reply was filed after the date of filing a Notice of Appeal, but prior to the date of filing an appeal brief. The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
- (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ They raise the issue of new matter (see NOTE below);
- (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☐ Applicant's reply has overcome the following rejection(s): _____.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
- The status of the claim(s) is (or will be) as follows:
- Claim(s) allowed: _____.
- Claim(s) objected to: _____.
- Claim(s) rejected: _____.
- Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☒ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☒ Other: see attached document.

Certain defects are noted in the Rule 131 Declaration filed on February 24, 2005.

The first noted defect is that the latest submission is not complete. Applicant originally submitted an apparently unsigned 131 affidavit with exhibit by the inventor accompanied by an affidavit from the practitioner. The latest after final submission contains a supplemental affidavit, but the original is still not signed. Therefore, it and its exhibit cannot be considered.

Should applicant wish to have the Office consider the affidavits, all documents and evidence should be signed and resubmitted.

However, in the interest of compact prosecution, the examiner will briefly note defects in the filings of both the October 4, 2004, and the February 24, 2005, Rule 131 Declarations:

- Exhibit A is not legible. A clearer and larger print document is advisable upon next submission. Due to faxing and scanning, the small print becomes harder to read.
- Inventor's affidavit and Exhibit A appears to fail to prove conception and/or diligence.
 - The inventor's affidavit amounts to general allegations and mere pleadings about conception of the claimed invention (see MPEP 715.07).
 - The latest remarks by the practitioner in the after final response appear to be an attempt to map the claimed limitations to the exhibit. However, this is not considered to be part of the affidavit and thus is not acceptable as evidence.
Applicant is invited to map the limitations in an affidavit.
 - Both the applicant's and the practitioner's affidavits should only address matters of which they have first hand knowledge and to provide dates to accompany statements when available (or an explanation of how the fact presented is known).

- The practitioner's statement appears to be an attempt to prove diligence in the preparation of the prosecution of the application. However, the statements do not fully address the concepts found in MPEP 2138.06.
- The statement is from in-house supervisory counsel and discusses in general terms his interactions with the inventor and outside counsel who drafted the application. There is no affidavit from outside counsel whose actions are being relied upon to establish diligence.
- The showing of diligence is vague and general with no specificity as to acts and dates.
- The practitioner has not indicated whether the work load during the period was normal, whether the applications were processed in chronological order, etc.
- It appears Exhibit A, filed October 4, 2004, raises a question regarding the status of the invention as being "announced, offered for sale, sold..." more than one year prior to applicant Smith's filing date of January 21, 2001. See Exhibit A, first page.



AYAZ SHEIKH
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100